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10/651,911

08/29/2003

Robert A. Cordery

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06/15/2006

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EXAMINER

WOO, ISAAC M

ART UNIT

PAPER NUMBER

2166

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/651,911

**Applicant(s)**

CORDERY ET AL.

**Examiner**

Isaac M. Woo

**Art Unit**

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is response to the application filed, on August 29, 2003. Claims 1-26 are presented for examination.

#### ***Claim Objections***

2. Claims 1, 12 and 23-26 are objected to because of the following informalities:

“said profile database” in line 12 of claim 1, in line 11 of claim 12, in line 11 of claim 25 and in line 11 of claim 26, should be -- said user profile database --;

“said related value rating database” in lines 14-15 of claim 12, should be -- a related value rating database --;

“said user profile database” in lines 11-12 of claim 23 and claim 24, should be -- said profile database --;

“said user profile database” in lines 4-5 of claim 25 and lines 4-5 of claim 26 should be -- a user profile database --;

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

4. Claims 25-26 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the  
Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to

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*have a practical application.*

Claims 25-26 are non-statutory. Because "computer readable medium" in line 1 of claims 25-26, is insufficient to render the claim tangibly embodied in a manner so as to executable. Specification page 6, lines 13-19, defines media as including carrier wave, in addition to hard and optical medium. Carrier wave is intangible media. Thus, the claims 25-26 are not a statutory and should be rejected under 35 U.S. C. § 101 as not being tangible. The claim limitation needs to specify what "machine-readable medium" refers to, such as, "computer-readable storage medium". And "the instructions" are not embedded on the "computer readable medium" and not run by any the "computer readable machine". Therefore, the claims are not a statutory system and should be rejected under 35 U.S. C. § 101 as not being tangible.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12, 20, 24, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites, "high estimated value" in lines 1-2. Claims 12, 24 and 26 recite,

"relatively higher estimated values" in line 24, in line 31 and in line 24, respectively, which renders the claims indefinite. Claim 21 recites, "likely fruitfulness" in line 5, which renders the claim indefinite. The terms "high", "relatively higher" and "likely" are not defined by the claim, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Examiner interprets the terms, "high estimated value" to mean "estimated value", "relatively higher estimated values" to mean "estimated value" and "likely fruitfulness" to mean "fruitfulness". The application will be examined according to the given meanings discussed above. See MPEP 2173.05(b), Relative Terminology F.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-8, 10-11, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Huper-Graff et al (U.S. Pub. No. 2004/0044677, hereinafter, "Huper-Graff").

With respect to claim 1, Huper-Graff teaches a method for creating and maintaining a user profile database (i.e., creates and updates behavioral profiles of users, page 2, section 0031, page 1, section 0010) and a related value rating database for a plurality of information sources (i.e., scoring, scoring rate, the available content and services, page 1, section 0010, page 3, section 0038), Huper-Graff teaches a) receiving fixed information for each of a plurality of users (i.e., user preference, page 2, section 0031); Huper-Graff teaches b) initializing profiles for each of the users in the user profile database with the fixed information (i.e., creates behavioral profiles of users with user preference, (user profile) in personal dynamic profile, PDP, database, (page 2, fig. 2, section 0026), page 2, section 0031); Huper-Graff teaches c) monitoring a user and receiving monitored information relating to the user (i.e., real-time tracking user activities that are stored in the viewer history log, page 3, sections 0039-0040); Huper-Graff teaches d) determining if the monitored information relates to a particular information source (i.e., content, service or internet search, etc., page 3, section 0040), (i.e., analyzing history log to detect user access record, page 3, sections 0041-0045) and, if so, determine a value rating for the particular information source in accordance with the monitored information (i.e., each accessed content and services are scored, and parameter value of behavioral profiles is changed for accessed services, page 2, section 0031, page 3, section 0045, fig. 4-6); Huper-Graff teaches e) creating an updated profile for the user in the profile database in accordance with the monitored information (i.e., updates behavioral profiles of users by user history activities, page 2, section 0031, page 3, section 0045, fig. 4-6); and Huper-Graff teaches f) if a value rating

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is determined, associating the value rating with the updated user profile (i.e., accessed content and services scored and matched with each PDP parameters, page 1, section 0010, page 2, section 0031) and recording the value rating in the related value rating database (i.e., rate for each source is updated and stored in PDP database in fig. 2, fig. 4, fig. 6, page 2, sections 0026-0031, page 3, section 0041-0045).

With respect to claim 2, Huper-Graff teaches the updated profile includes information selected from the monitored information (i.e., tracking user activities through Internet and storing in the viewer history log, page 3, sections 0039-0040) and used to determine the value rating (i.e., each accessed content and services are scored, page 2, section 0031, fig. 4-6).

With respect to claim 3, Huper-Graff teaches the updated profile includes the value rating (i.e., rate for each source is updated and stored in PDP database in fig. 2, fig. 4, fig. 6, page 2, sections 0026-0031, page 3, section 0041-0045).

With respect to claim 4, Huper-Graff teaches the updated profile includes search queries the user has submitted to an information source (i.e., conducting search internet, page 3, section 0040).

With respect to claim 5, Huper-Graff teaches the updated profile includes the user's interaction history with regard to an information source (i.e., conducting search



internet, page 3, section 0040).

With respect to claim 6, Huper-Graff teaches the fixed information includes answers to survey questions (i.e., user preferences, page 2, section 0031).

With respect to claim 7, Huper-Graff teaches the databases are created and maintained by a trusted third party system (i.e., Recommendation learning system includes PDP and CAM database in fig. 1, fig. 2, page 2, sections 0024-0026).

With respect to claim 8, Huper-Graff teaches the value rating is multi-valued (page 2, section 0023).

With respect to claim 10, Huper-Graff teaches the monitoring step is carried out by directly monitoring interactions between a network and a user controlled system for accessing information sources through the network (page 3, section 0040).

With respect to claim 11, Huper-Graff teaches earlier user profiles and their associated value ratings are retained after updating (i.e., scoring the services based on real-time user activities tracking, page 3, section 0039-0043).

With respect to claim 23, Huper-Graff teaches a system (page 1, section 0001),  
a) a server (i.e., dynamic recommendations system in fig. 2, page 2, section 0026); b) a

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profile database (i.e., PDP database in fig. 2, page 2, section 0026); c) a related value rating database (i.e., in PDP database in fig. 2, page 1, section 0010, page 2, section 0026); d) the server communicating with a profile database and a related value rating database (i.e., fig. 2); e) the server also communicating with a plurality of monitors for monitoring a corresponding plurality of users (i.e., recommendations learning system communicate with users in fig. 1, page 2, sections 0024-0026); f) the server being programmed to: f1) receive fixed information for each of a plurality of users (i.e., user preference, page 2, section 0031); Huper-Graff teaches f2) initialize profiles for each of the users in the profile database with the fixed information (i.e., creates behavioral profiles of users with user preference, (user profile) in personal dynamic profile, PDP, database, (page 2, fig. 2, section 0026), page 2, section 0031); Huper-Graff teaches f3) monitor a user and receive monitored information relating to the user (i.e., real-time tracking user activities that are stored in the viewer history log, page 3, sections 0039-0040); Huper-Graff teaches f4) determine if the monitored information relates to a particular information source (i.e., analyzing history log to detect user access record, page 3, sections 0041-0045) and, if so, determine a value rating for the particular information source in accordance with the monitored information (i.e., each accessed content and services are scored, page 2, section 0031, fig. 4-6); Huper-Graff teaches f5) create an updated profile for the user in the profile database in accordance with the monitored information (i.e., updates behavioral profiles of users by user history activities, page 2, section 0031, page 3, section 0045, fig. 4-6); and Huper-Graff teaches f6) if a value rating is determined, associating the value rating with the updated

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user profile (i.e., accessed content and services scored and matched with each PDP parameters, page 1, section 0010, page 2, section 0031) and recording the value rating in the related value rating database (i.e., rate for each source is updated and stored in PDP database in fig. 2, fig. 4, fig. 6, page 2, sections 0026-0031, page 3, section 0041-0045).

The limitations of claim 25 (computer readable medium claim) are rejected in the analysis of claim 1 above, and these claims are rejected on that basis.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over by Huper-Graff et al (U.S. Pub. No. 2004/0044677, hereinafter, "Huper-Graff") in view of Oulu et al (U.S. Patent No. 6,792,460, hereinafter, "Oulu").

With respect to claim 9, Huper-Graff discloses the monitoring step. Huper-Graff does not explicitly disclose the monitoring is selectively enabled by the user. However,

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Oulu teaches that the monitoring is selectively enabled by the user (col. 7, lines 19-31).

Therefore, based on Huper-Graff in view of Oulu, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to utilize the teaching of Oulu to the system of Huper-Graff in order to control the monitoring system for data collection by user (col. 7, lines 9-31).

***Allowable Subject Matter***

9. Claims 12-22, 24 and 26 are allowed over prior art.


Claim 12, 24 and 26 identify the distinct feature that calculating an estimated value to the user of an information source as a function of the user's profile, profiles for others of the users, and value ratings for the information source associated with the other users profiles, repeating until estimated values have been calculated for all of the information sources, selecting and outputting to the user information sources having estimated values. The closest prior art, Huper-Graff et al (U.S. Pub. No. 2004/0044677), fails to suggest the claimed limitations as mentioned above in combination with other claimed elements. Claims 13-22, further depending from claim 12, are also allowed.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Isaac Woo  
June 9, 2006